

**IN THE UNITED STATES DISTRICT COURT
FOR THE EASTERN DISTRICT OF VIRGINIA
Norfolk Division**

BIONTECH SE, BIONTECH
MANUFACTURING GMBH, and PFIZER,
INC.,

Plaintiffs/Counterclaim Defendants,

v.

CUREVAC SE (f/k/a CUREVAC AG),

Defendant/Counterclaimant,

and

CUREVAC MANUFACTURING GMBH,

Counterclaimant.

C.A. No. 2:23-cv-222-JKW-DEM

JURY TRIAL DEMAND

STIPULATION AND MOTION FOR PARTIAL DISMISSAL

WHEREAS, in this Action, CureVac SE and CureVac Manufacturing GmbH (“CureVac”) assert causes of action for infringement of U.S. Patent No. 11,241,493 (the “’493 Patent”), U.S. Patent No. 11,471,525 (the “’525 Patent”), U.S. Patent No. 11,576,966 (the “’966 Patent”), and U.S. Patent No. 11,596,686 (the “’686 Patent”) against BioNTech SE and BioNTech Manufacturing GmbH (“BioNTech”) and Pfizer, Inc. (“Pfizer”);

WHEREAS, pursuant to an agreement with Acuitas Therapeutics Inc. (“Acuitas”), CureVac has agreed to dismiss with prejudice its causes of action for infringement with respect to all claims of the ’493 Patent (Count VIII), all claims of the ’525 Patent (Count IX), and all claims of the ’966 Patent (Count X); has filed at the U.S. Patent & Trademark Office disclaimers of claims 19-25 and 27-30 of the ’686 Patent (Count XI) and has agreed to cease asserting those disclaimed claims; and has agreed to dismiss with prejudice all allegations that Acuitas violated its

confidentiality obligations or that Acuitas's actions support or are the bases for any willful infringement allegations against BioNTech and/or Pfizer, including, e.g., CureVac's allegations in Paragraphs 179, 180, 197, and 198 of Docket No. 106;

WHEREAS, on April 25, 2024, CureVac notified the Court that all disputes between CureVac and Acuitas have been settled. *See* ECF No. 262 and 270; and

WHEREAS, pursuant to Federal Rule of Civil Procedure 41, CureVac seeks to dismiss with prejudice its causes of action for infringement with respect to all claims of the '493 Patent (Count VIII), all claims of the '525 Patent (Count IX), all claims of the '966 Patent (Count X), and stipulates not to assert Claims 19-25 and 27-30 of the '686 Patent (Count XI); and all allegations that Acuitas violated its confidentiality obligations or that Acuitas's actions support or are the bases for any willful infringement allegations against BioNTech and/or Pfizer, including, e.g., CureVac's allegations in Paragraphs 179, 180, 197, and 198 of Docket No. 106.

NOW, THEREFORE, IT IS HEREBY STIPULATED, subject to the approval and order of the Court, that:

- i. CureVac has filed disclaimers of claims 19-25 and 27-30 of the '686 Patent with the United States Patent and Trademark Office as provided by 35 U.S.C. § 253, and those claims shall not be asserted by CureVac.
- ii. Acuitas agrees that it has licensed BioNTech with respect to all claims of the '493 Patent, the '525 Patent, and the '966 Patent, with the right to sublicense to Pfizer, and that such licenses are and have been in effect for the entire period since those patents issued;
- iii. All of CureVac's claims concerning the '493 Patent, the '525 Patent, and the '966 Patent, including Counts VIII-X of CureVac's First Amended Counterclaims (D.I. 106 ¶¶ 165-

219), and CureVac's claims concerning claims 19-25 and 27-30 of the '686 Patent (D.I. 106 ¶¶ 220-239), are dismissed with prejudice;

- iv. BioNTech and Pfizer's defenses and counterclaims with respect to the '493 Patent (D.I. 1 ¶¶ 114-118; D.I. 252 ¶¶ 74-77), the '525 Patent (D.I. 252 ¶¶ 78-81, 101-103), the '966 Patent (D.I. 252 ¶¶ 82-85; 104-106), and claims 19-25 and 27-30 of the '686 Patent (D.I. 252 ¶¶ 86-89; 107-109), are dismissed without prejudice.
- v. Pursuant to Federal Rule of Civil Procedure 41(a)(1)(A)(ii) or (a)(2), Acuitas is dismissed as a party to this action; provided, however, that the Court shall maintain jurisdiction over Acuitas for the limited purpose of resolving disputes and issuing any orders relating to the Notice of Deposition Pursuant to Federal Rule of Civil Procedure 30(b)(6) served on Acuitas by BioNTech and Pfizer on May 17, 2024.
- vi. CureVac covenants not to assert any claims of the '493 Patent, any claims of the '525 Patent, any claims of the '966 Patent, or claims 19-25 and 27-30 of the '686 Patent, against BioNTech or Pfizer, or to accuse COMIRNATY[®] of infringing the '493 Patent, the '525 Patent, the '966 Patent, or claims 19-25 and 27-30 of the '686 Patent, in this or any other action or proceeding.
- vii. CureVac agrees that it will not make any assertions that Acuitas or BioNTech or Pfizer violated any confidentiality obligations, or that any action by Acuitas, or any action by BioNTech or Pfizer with respect to Acuitas, supports or is a basis for any willful infringement allegations against BioNTech and/or Pfizer in this or any other action or proceeding.
- viii. CureVac will not assert or suggest, directly or indirectly, expressly or impliedly, any wrongdoing or misconduct relating to BioNTech and/or Pfizer's work with Acuitas, or

BioNTech and/or Pfizer's use of Acuitas's LNPs or components thereof, in this or any other action or proceeding, including without limitation in support of any claim of willfulness of infringement or exceptional case.

- ix. CureVac agrees not to seek discovery from BioNTech or Pfizer (including document production and depositions) relating to Acuitas's LNPs, in any action against BioNTech and/or Pfizer regarding COMIRNATY®.

Dated: June 11, 2024

By: /s/ Stephen E. Noona
Stephen E. Noona (VSB No. 25367)
Clark J. Belote (VSB No. 87310)
KAUFMAN & CANOLES, P.C.
150 W. Main Street, Suite 2199
Norfolk, VA 23510-1665
Telephone: (757) 624-3000
Facsimile: (888) 360-9092
senoona@kaufcan.com
cjbelote@kaufcan.com

*Counsel for BioNTech, SE, BioNTech
Manufacturing GmbH, and Pfizer, Inc.*

Bruce M. Wexler (*pro hac vice*)
Eric W. Dittmann (*pro hac vice*)
Young J. Park (*pro hac vice*)
Max H. Yusem (*pro hac vice*)
Michael F. Werno (*pro hac vice*)
Mi Zhou (*pro hac vice*)
PAUL HASTINGS LLP
200 Park Avenue
New York, NY 10166
Telephone: (212) 318-6000
Facsimile: (212) 319-4090
brucewexler@paulhastings.com
michaelwerno@paulhastings.com
ericdittman@paulhastings.com
youngpark@paulhastings.com
mizhou@paulhastings.com
maxyusem@paulhastings.com

By: /s/ Christopher W. Bascom
Dana D. McDaniel (VSB No. 25419)
John M. Erbach (VSB No. 76695)
M. F. Connell Mullins, Jr. (VSB No. 47213)
Christopher W. Bascom (VSB No. 87302)
Clay S. Hester (VSB No. 93051)
SPOTTS FAIN P.C.
411 E. Franklin St., Suite 600
Richmond, VA 23219
T: (804) 297-2000
F: (804) 697-2144
E: dmcdaniel@spottsfain.com
jerbach@spottsfain.com
cmullins@spottsfain.com
cbascom@spottsfain.com
chester@spottsfain.com

Mark H. Izraelewicz (admitted *pro hac vice*)
Kevin M. Flowers (admitted *pro hac vice*)
John R. Labbe (admitted *pro hac vice*)
Michael R. Weiner (admitted *pro hac vice*)
Sandip H. Patel (admitted *pro hac vice*)
Michael J. Allikian (admitted *pro hac vice*)
Thomas R. Burns (admitted *pro hac vice*)
Chelsea M. Murray (admitted *pro hac vice*)
Izabella N. C. Higson (admitted *pro hac vice*)
Daniel Gonzalez (admitted *pro hac vice*)
MARSHALL GERSTEIN & BORUN LLP
233 S. Wacker Dr., Suite 6300
Chicago, Illinois 60606

*Counsel for Plaintiffs BioNTech SE and
BioNTech Manufacturing GmbH*

Dimitrios T. Drivas (*pro hac vice*)
John P. Scheibeler (*pro hac vice*)
Kevin J. Georgek (*pro hac vice*)
Samantha J. Kokonis (*pro hac vice*)
WHITE & CASE LLP
1221 Avenue of the Americas
New York, NY 10020
Telephone: (212) 819-8200
Facsimile: (212) 354-8113
ddrivas@whitecase.com
jscheibeler@whitecase.com
kevin.georgek@whitecase.com
samantha.kokonis@whitecase.com

Counsel for Plaintiff Pfizer Inc.

By: /s/ Robert W. McFarland

Robert W. McFarland (VSB No. 24021)

MCGUIREWOODS LLP

World Trade Center
101 W. Main Street, Suite 9000
Norfolk, Virginia 23510-1655
Telephone: (757) 640-3716
Facsimile: (757) 640-3966
E-mail: rmcfarland@mcguirewoods.com
Nicholas Groombridge (admitted *pro hac vice*)
Eric Alan Stone (admitted *pro hac vice*)
Josephine Young (admitted *pro hac vice*)
Allison C. Penfield (admitted *pro hac vice*)
Chih-Wei Wu (admitted *pro hac vice*)
GROOMBRIDGE, WU, BAUGHMAN & STONE
565 Fifth Avenue, Suite 2900
New York, NY 10017
nick.groombridge@groombridgewu.com
eric.stone@groombridgewu.com
josephine.young@groombridgewu.com
allison.penfield@groombridgewu.com
Telephone: (332) 269-0030

*Attorneys for Intervenor Acuitas Therapeutics
Inc.*

T: 312.474.6300
E: mizraelewicz@marshallip.com
kflowers@marshallip.com
jlabbe@marshallip.com
mweiner@marshallip.com
spatel@marshallip.com
mallikian@marshallip.com
tturns@marshallip.com
cmurray@marshallip.com
ihigson@marshallip.com
dgonzalez@marshallip.com

*Attorneys for Defendants-Counterclaimants
CureVac SE and CureVac Manufacturing
GmbH*